

REMARKS

Claims 1-26 are pending in the application. Claims 7-15, 20-23, and 26 have been withdrawn from consideration, thereby leaving Claims 1-6, 16-19, 24, and 25 remaining in the application. In an Office Action mailed February 19, 2003, all claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,856,715, issued to Peot et al. and U.S. Patent No. 6,198,195, issued to Embree et al. The Office Action admits that Peot et al. fails to teach a motor having a length to diameter ratio of 1:1.5. Embree et al. has been cited for the purpose of establishing that a motor of such a ratio is common in tools. Applicants respectfully disagree.

Applicants respectfully note that the Office Action has failed to establish a *prima facie* case of obviousness. As the PTO recognizes in MPEP § 2142:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with the production of evidence in each step of the examination process . . . The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

Applicants further note that there must be a basis in the art for combining or modifying the references. Specifically, MPEP § 2143.01 provides that the mere fact that references "can be combined or modified does not render the resultant combination obvious *unless* the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)(emphasis added). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention "absence some teaching suggestion or incentive supporting the combination." *ACS Hospital Systems, Inc. v. Monteffiore Hospital*, 732 F.2d 1572, 1577, 21 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Thus, there must be some teaching, suggestion, or incentive in the prior art for combining or modifying the references. Applicants

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respectfully submit that there is no such teaching, suggestion or incentive within the cited references.

Peot et al., the primary reference, generally disclose a portable electrical power tool having a rare earth permanent magnet motor. As the Office Action correctly admits, there is no teaching or suggestion within Peot et al. of a power tool that include a motor assembly having a length to diameter ratio that is substantially between a range of 1:1.5 and 1:4.5, as generally set forth in amended Claim 1. Applicants further submit that there is no teaching or suggestion within Peot et al. of a power circular saw that includes a motor assembly having a length to diameter ratio that is substantially in a range of 1:1.5 and 1:4.5, as now generally set forth in amended Claims 16, 24, and 25. Instead, Peot et al. merely disclose a motor 22 which is a "permanent magnet DC motor formed using very high strength rare earth magnets." Column 3, lines 37-38. Applicants respectfully submit that Embree et al. fail to teach or suggest the foregoing shortcoming of Peot et al. and, therefore, cannot overcome the deficiencies of Peot et al.

Embree et al. generally disclose a motor for low velocity, high volume fans and other applications. As may be best seen by referring to Figures 3 and 4, the motor 10 include a stator 16 and an armature 12 interconnected by a motor shaft 28. Applicants respectfully submit that there is no teaching or suggestion with Embree et al. of a motor assembly having a length to diameter ratio that is substantially between a range of 1:1.5 and 1:4.5, as generally set forth in amended Claim 1. Similarly, applicants respectfully submit that Embree et al. are also silent with respect to a motor assembly having a length to diameter ratio that is substantially in a range of 1:1.5 and 1:4.5, as generally set forth in amended Claims 16, 24 and 25. Instead, Embree et al. merely teach an armature 12 that includes a variety of diameters which may be stacked to a predetermined height. However, Embree et al. is completely silent with respect to a *motor*

assembly having a length to diameter ratio, as now generally set forth in amended Claims 1, 16, 24, and 25. Accordingly, applicants respectfully submit that there is no teaching, suggestion or motivation to combine the teachings of Peot et al. and Embree et al. and, therefore, no *prima facie* case of obviousness has been established.

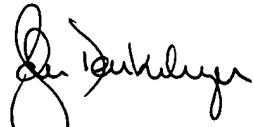
Applicants respectfully submit that the dependent claims depending from either Claims 1 or 16 are thus allowable for the reasons discussed above. In addition, the dependent claims have further limitations that distinguish over the cited references whether taken individually or in hypothetical combination. Therefore, applicants respectfully submit that the dependent claims of the present application should also now be found allowable.

CONCLUSION

In light of the foregoing amendments and remarks, applicants respectfully submit that the present application is now in condition for allowance. Applicants respectfully request reconsideration and allowance of all claims. The Examiner is invited to telephone the undersigned if there are any remaining issues.

Respectfully submitted,

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